

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-35.

The following claims are *independent*: 1, 16 and 21.

The following claims have previously been *withdrawn*: 35.

Please *amend* claims 1, 16 and 21; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Examiner Interview

Applicant thanks the Examiner for taking the time to discuss the pending Office Action and the pending claims on February 23, 2010 and July 20, 2010.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 1-20 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action asserts the “specification does not disclose the ‘compliance rule engine’ is updated” (Office Action, p. 3, ¶1). Although Applicant respectfully disagrees and submits previously presented claims are fully supported throughout the originally filed specification, claims and figures, Applicant has amended independent claims 1 and 16 to provide further clarification.

Applicant further submits the claimed “dynamically updating a baseline rule set, an additional rule set and a rule exceptions set via the compliance rules engine” as recited in amended independent claim 1 is fully supported throughout the originally filed specification, claims and figures (by way of non-limiting example only, page 16, lines 5-15 of the originally filed specification).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1 and 2 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Cwenar (US 5,893,079; hereinafter, “Cwenar”) in view of Rhonda Bissig (“Merrill, ex-broker hit with multi-million dollar lawsuit in N.H.,” Rhonda Bissig, Wall Street Letter, New York: Feb. 7, 2000, Vol. 32, Iss. 6, pp. 1-2; hereinafter, “Bissig”) and in further view of Tuttle (US 7,412,417; hereinafter “Tuttle”). The Office Action rejected claims 3-15 and

22-34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cwenar in view of Bissig in further view of Tuttle, and in further view of alleged “Applicant’s Admitted Prior Art (APA).” The Office Action rejected claim 16 and 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cwenar in view of Bissig and Tuttle in further view of Beale (WO 98/59307; hereinafter, “Beale”).

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, “the obviousness or nonobviousness of the subject matter [be] determined,” and details further requirements, commonly referred to as “Graham factors,” which include that “[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved.” *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and

¹ The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(A)** and **(B)** and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following element(s) as recited, *inter alia*, in independent claim 1:

processing by the computer compliance system the retrieved rule set to determine at least one applicable compliance rule selected based on the party's profile information, the profile reflecting at least the relationship between the associated party and the entity;

...

dynamically updating a baseline rule set, an additional rule set and a rule exceptions set via the compliance rules engine;

...

The Office Action asserts Cwenar discusses the previously presented “processing via

the computer system the retrieved rule set to determine at least one applicable compliance rule selected based on the party's profile information." Specifically, the Office Action asserts:

see col. 2 lines 41-51, col. 10 lines 23-35, col. 13 lines 3-9 - col. 10, the paragraph reads "... users to access the central database 101 simultaneously and enters inquiries (request) and receive all data permitted within whatever rules (col. 13 "if a propose prospectus is in compliance with legal rules and preference rules." - the rules have to be compliance rules; col. 2 group of rules. (Office Action, p. 4, ¶ 2).

Applicant respectfully traverses the rejections and submits the Office Action has mischaracterized Cwenar.

Contrary to the Examiner's assertions, Applicant submits Cwenar generically discusses a user receiving investment data permitted with rules, but does not discuss the "rule" is "selected based on the party's profile information." For example, Applicant notes Cwenar generically discusses compliance check, e.g., "[t]he compliance system may also be employed to determine if a proposed prospectus is in compliance with legal rules and preference rules" (Cwenar, col. 13, lines 3-5). Applicant further notes Cwenar discusses user interfaces for a user to enter inquiry data, e.g., "external user interface means ... permit users to access the central database 101 simultaneously and enter all inquiries and receive all data permitted within whatever rules have been established with respect to a specific user" (Cwenar, col. 10, lines 26-30). Applicant submits Cwenar's compliance procedure with user entering inquiries via an user interface, does not mention any "profile information," nor "dynamically updating" rule sets, much less the claimed

processing by the computer compliance system the retrieved rule set to determine at least one applicable compliance rule selected based on the party's profile information ... dynamically updating a baseline rule set, an additional rule set and a rule exceptions set via the compliance rules

engine ...

as recited in independent claim 1.

Applicant further notes the Office Action acknowledges “Cwenar does not explicitly disclose the profile reflecting at least the relationship between the associated party and the entity,” but then alleges Bissig remedies this deficiency. Specifically, the Examiner alleges:

the article shows the relationship of agent with brokerage firm “David allegedly engaged in trading activities that are a violation of both Merrill and industry compliance rules ... David’s alleged relationship with Canadian mining company Naxos Resources ...” ... It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cwenar and include profile reflecting at least the relationship between the party and the entity ... to provide system to monitor the violation and compliance rule with respect to the party engaged in the trade ... (Office Action, p. 5, ¶ 1).

Applicant respectfully disagrees, and submits Bissig discusses a news story of an ex-broker involved in unauthorized transactions. Applicant submits one of ordinary skill in the art would not combine Cwenar’s investment data processing system with Bissig’s news story of unauthorized transactions. Applicant submits that merely citing an alleged utility of a reference’s own system, without providing any attendant explanation or articulation of how that alleged utility points beyond the reference to the modifications of the references proposed in the pending rejection, is insufficient to support an assertion of obviousness under 35 U.S.C. § 103. MPEP §2141 (III) states, *inter alia*, “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious,” and that, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Applicant submits that, by merely quoting alleged rationales of the applied references, the pending rejection has failed to

provide a “clear articulation of the reason(s)” or an “articulated reasoning with some rational underpinning” for the proposed modifications of the references. Therefore, Applicant submits that a *prima facie* showing of obviousness has not been made and respectfully requests reconsideration and withdrawal of this basis of rejections. Applicant further requests that the Examiner clarify exactly why he believes the specific modifications, taken in relation to the claims as wholes, would allegedly have been obvious to one of ordinary skill in the art at the time the invention was made.

Similarly, Applicant submits Tuttle’s “auditing loan compliance with state and federal laws and regulations” (Tuttle, Abstract) fails to remedy the deficiency in Cwenar in view of Bissig. As such, Applicant submits the pending rejection has not established a *prima facie* case of obviousness.

Although of different scope than independent claim 1, Applicant submits claims 16 and 21 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action’s application of Cwenar in view of Bissig with regard to independent claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations

(e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-35, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-019. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-019.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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